

REMARKS

Reconsideration of the application is respectfully requested. No amendments to the claims are made herein. Claims 50-58 remain pending in the application and are presented for the Examiner's reconsideration in view of the following remarks.

Claims 53 and 57 stand rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the enablement requirement. Claims 53 and 57 recite that a connection between the first output terminal and the external device is preferentially selected. The Examiner asserts that these recitations are not supported by enabling description in the specification.

Applicants traverse this rejection. The specification clearly supports preferentially selecting the first output terminal for the connection. Applicants also note that preferential selection is recited in claims 5 and 14 of the originally filed application. The specification, at pg. 35, lns. 4-16, describes that processing first checks whether or not equipment is connected to a first output terminal (an IEEE interface), referring to step S21 in Figure 10. If equipment is connected, then an inquiry command is issued, and a response is awaited (S22). If the response comes back as YES, processing continues, resulting in transmission of an encoded data signal. However, as described in the specification at pg. 36, lns 12-14, if there is no connected equipment, or there is no response to the inquiry command, ONLY then does processing shift to checking for equipment connected to a second output terminal (S28 FIG. 11). Hence, the specification describes preferential selection of the first output terminal.

Claims 50-52, 54-56 and 58 stand rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,199,076 B1 issued March 6, 2001 to Logan et al. ("Logan") in view of U.S. Patent No. 6,516,299 B1 issued February 3, 2003 to Case ("Case"). In addition, claims 53 and 57 stand rejected under 35 U.S.C. 103(a) as being unpatentable over *Logan*, in view of *Case*, and further in view of uncited, but assertedly "well-known" prior art.

As recited in the presently pending claims, the invention is a device for receiving compressed digital data. The device includes a first output terminal for providing compressed digital data to an external device, and a second output terminal for providing decoded digital data to the external device.

In order for the rejection of the claims under 35 U.S.C. §103(a) to be maintained, every feature recited in the claims must be taught by the cited references. Applicants respectfully submit that this requirement has not been met. Neither *Logan* nor *Case*, nor the combination of *Logan* and *Case*, teaches the features of the presently pending claims.

The passages in *Logan* cited by the Examiner do not support the Examiner's assertions. First, *Logan* does not output compressed digital data. The passage cited by the Examiner at col. 4, line 46-50 of *Logan* merely refers to use of a stereo codec of a sound card for decoding compressed audio recordings and for synthesizing speech from text data. The sound card performs "digital to analog conversion for programming directed to the speaker." Col. 4, lns. 58-59. The output of the sound card is an analog audio signal provided for directly driving a speaker, headphones or other Line-Out. Col 4, lns. 59-61. In no

way is an analog audio output "compressed digital data" as recited in the presently pending claims.

Nor does *Logan* teach or suggest that the output line from the sound card to the speaker or other device is a bi-directional line. While the "sound card provides external connections and hardware support for Microphone-In, Line-In, Line-Out, and Headphones-Out" (col. 4, lines 59-61), *Logan* in no way teaches or suggests that any of those inputs and outputs should be considered to be other than conventional (analog) inputs and outputs for interfacing with a conventional analog speaker, microphone, or other device.

Notwithstanding the passage cited by the Examiner at col. 7, lines 63-66, *Logan* neither teaches nor suggests the claimed feature that decoded digital data is provided over a one-way communication line to the external device. The cited passage merely refers to the storage of downloaded files on an optical disk cartridge. The cited passage neither teaches nor suggests an output terminal, a communication line for attachment thereto, nor does it teach a one-way communication line, as recited in the claims. Moreover, *Logan* neither teaches nor suggests providing data that is digital in form and decoded over an output terminal to an external device.

The Examiner states that it is well known in the art for a device to "selectively provid[e] datatype to a device as a function of device capabilities." In rejecting the claims, it is not a sufficient basis for the Examiner to merely assert that a feature recited in the claims is "well known in the art." If the assertion of official notice is challenged by the Applicant, the Examiner must indicate a prior art reference that teaches such feature. (MPEP 2144.03).

Applicants disagree that it is well known in the art for a device to "selectively provide[e] datatype to a device as a function of the device capabilities." It is not well known for a device providing output to another, external device to be controlled in accordance with the capabilities of the external device which receives the output therefrom. By contrast, what is well known is that transmitting devices which provide output to other devices do so without regard to whether and what kind of devices are connected thereto to receive the output. To the extent that the Examiner points to features being "well known in the art," Applicants respectfully traverse the rejections and request that the Examiner support the assertions by the citation of prior art.

Nor does *Case* provide the teachings which *Logan* lacks with respect to the presently claimed invention. *Case* does not teach outputting decoded digital data. *Case* merely describes a method of modifying an encoded audio signal in accordance with a playback destination. The encoded audio signal is modified with a first scale factor for one destination, and is modified with a second scale factor for another destination. The audio signal is not decoded prior to output to the external device, but remains an encoded audio signal in each case.

In addition, *Case* describes a system having only one output terminal 62 from the processor 50. As shown in FIG. 3, a single one-way communication line extends from the output terminal, which then separates at the inputs of playback destinations 56-60. Thus, *Case* fails to teach a first output terminal for providing compressed digital data on a bi-directional communication line and a second output terminal for providing decoded digital data on a one-way communication line.

Further, contrary to the Examiner's assertion, Case fails to teach or suggest a controller that controls the device in accordance with the connection state between the device and an external device. Case merely describes that the processor modifies the encoded audio signal based on the particular destination identified for playback via control input. Case does not teach or suggest that the control input relates to the connection state between the processor and the playback destination.

Similar distinguishing features are recited in Applicants' independent claims 54 and 58. In view of the above, Applicants respectfully submit that the independent claims 50, 54 and 58 are allowable over the cited art, as are claims 51-53, and 55-57 which depend therefrom.

As to the specific rejections of claims 53 and 57, neither *Logan* nor *Case*, nor the combination thereof, recites the particular features claimed in claims 53 and 57. Applicants respectfully traverse the Examiner's assertion that it is well known in the art to preferentially provide compressed data to an external device. However, that is not what is claimed. Claims 53 and 57 recite that the first output terminal (of a multi-output terminal device) is preferentially selected (for a connection to provide output). It is not well known to preferentially select a particular output terminal of a multi-output terminal device for providing output to an external device. The Examiner must support the rejection of this claimed feature by citation to prior art or the rejection cannot be maintained.

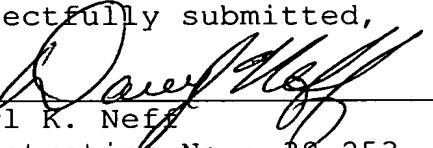
Accordingly, Applicants respectfully submit that all of the claims 50-58 are in condition for allowance.

As it is believed that all of the rejections set forth in the Official Action have been fully met, favorable reconsideration and allowance are earnestly solicited. If, however, for any reason the Examiner does not believe that such action can be taken at this time, it is respectfully requested that the Examiner telephone Applicants' attorney at (908) 654-5000 in order to overcome any additional objections which the Examiner might have.

If there are any additional charges in connection with this requested amendment, the Examiner is authorized to charge Deposit Account No. 12-1095 therefor.

Dated: July 18, 2003

Respectfully submitted,

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